

REMARKS

Claims 2-36 and 56 remain active in the application. Applicants respectfully make a second request of rejoinder of previously canceled claims 46 and 47, if the pending claims are found allowable.

The Examiner has withdrawn all of her prior rejections in view of the Applicants' previous response. However, the Examiner has lodged new grounds for rejection. In particular, the Examiner has cited the disclosure of Schnipelsky et al. (USP 5 229 297) as allegedly anticipating certain pending claims under Section 102(b). Among other things, the Examiner relies on Schnipelsky et al. as allegedly disclosing "a valve connected to an opening in the first conduit, wherein the valve is closed by contact with the sample (check valve present in first conduit, col. 10, lines 43-46; check valve closes upon contact with sample moving back through the conduit, col. 14, lines 42-49)." The Examiner further relies on Schnipelsky et al. as the primary reference in rejecting various other pending claims under Section 103(a) in combination with a number of other secondary references. Applicants respectfully traverse all of the Examiner's rejections.

Applicants' respectfully point out that the present traversal can be based on a number of different grounds. For the sake of economy, however, Applicants will focus this discussion on one element of claims 2 and 3 – the valve, which is "closed by contact with said sample." Applicants reserve the right to present other bases for their traversal in the event that the Examiner elects to maintain her rejections.

Applicants' respectfully contend that the Examiner has not met her burden of raising a proper basis for anticipation or obviousness because the primary reference that the Examiner has relied on does not meet all of the limitations of the claimed invention. Specifically, the Examiner admits that the valve taught by Schnipelsky et al. is a "one-way check valve." Office Action, for example, at page 6 ("Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to substitute for the one-way valve of Schnipelsky et al., a gelling polymer closed by contact with the fluid sample as taught by Wozniak et al., in order to provide a low cost one-way valve that does not require mechanical moving components.") Indeed, Schnipelsky et al.'s one-way check valve is not "closed" within the meaning of the claimed invention in that Schnipelsky et al.'s check valve permits downstream flow, while restricting upstream flow. On the other hand, Applicants' closeable

valve, once closed by contact with the sample, is sealed – that is, flow is restricted in both downstream and upstream directions. Accordingly, the disclosure of Schnipelsky et al. does not teach, disclose, or suggest the claimed invention. The Section 102(b) rejection having been overcome, its withdrawal is hereby respectfully requested.

Applicants further contend that none of the Examiner's secondary references remedies the shortcomings of Schnipelsky et al. Therefore, it is the Applicants position that the Examiner has failed to carry her burden of establishing a *prima facie* case of obviousness. Applicants' note that the Examiner appears to have succumbed to the insidious effects of hindsight reasoning, whereby the Applicants' own disclosure is being used time and again to pinpoint disparate and unrelated teachings of the prior art to piece together a combination of references. These combinations of references, on closer scrutiny, cannot sustain a rejection under Section 103(a). For example, the Examiner, in rejecting pending claim 13, has chosen a secondary piece of prior art that is arguably well outside and disconnected from the field of the primary reference.¹ Simply put, one of ordinary skill in the art would find no reasonable motivation to substitute a component of a containment cuvette with a component of a syringe assembly.

Even so, the Examiner's proposed combination is ill-fated for still other reasons. As mentioned in the above-quoted passage, the Examiner seeks to improperly substitute Schnipelsky et al.'s one-way valve with another one-way valve from Wozniak et al. As previously discussed in detail above, replacing a one-way valve with another one-way valve does not rise to the level of Applicants' closeable valve, which ultimately does not permit flow in both downstream and upstream directions. Moreover, even if *arguendo* Wozniak et al.'s teachings on a syringe assembly were apropos and even if *arguendo* Wozniak et al. might teach a closeable valve, why would one of ordinary skill in the art ignore the teachings of the primary reference, which calls for a one-way check valve, and use anything other than another one-way valve? It seems clear from the teachings of Schnipelsky et al. that the cuvette in question needs to permit at least a downstream flow while preventing an upstream backwash.

Having overcome the Examiner's obviousness rejections, Applicants respectfully request that the Examiner withdraw all her Section 103(a) rejections and reconsider the allowability of

¹ Compare, for example, the international and domestic classifications and fields of search between the secondary reference, Wozniak et al., and the primary reference, Schnipelsky et al.

all the pending claims, as amended. Applicants further solicit the Examiner's favor in granting their request for a rejoinder, as stated above.

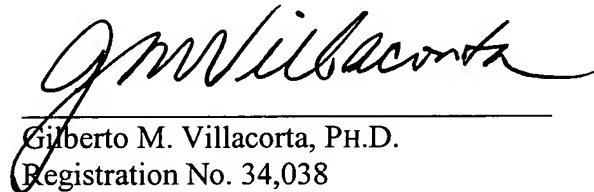
CONCLUSION

Applicants submit that the case is now in condition for allowance. Early notification of such action is earnestly solicited.

Applicants believe that no fee is due in connection with this filing. However, the Commissioner is hereby authorized to charge any fees due in connection with this filing to Deposit Account 50-1710 or credit any overpayment to same.

The undersigned attorney may be reached at our Washington, D.C. office by telephone at (202) 625-3838 (direct line). All correspondence should be directed to our Chicago address given below.

Respectfully submitted,



Gilberto M. Villacorta, PH.D.
Registration No. 34,038

Date: January 17, 2006

Patent Administrator
KATTEN MUCHIN ROSENMAN LLP
525 West Monroe Street
Chicago, Illinois 60661-3963
Fax: (312) 906-1021
Tel: (202) 625-3838